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In re Application of:	:	
TANG, Y., Tom, et al.	:	
U.S. Application No.: 10/531,164	:	DECISION ON PETITION UNDER
PCT No.: PCT/US2003/030720	:	37 CFR 1.47(a)
International Filing Date: 30 September 2003	:	
Priority Date: 02 October 2002	:	
Attorney's Docket No.: 819 CIP/PCT	:	
For: NOVEL NUCLEIC ACIDS AND	:	
PEPTIDES	:	

This decision is issued in response to applicants' three petitions under 37 CFR 1.47(a) filed 17 February 2006 and 07 July 2006. Applicants have paid separate \$200 petition fees for each of these petitions; however, only one petition fee is required. Accordingly, Deposit Account No. 50-1169 will be credited with a refund of \$400.

BACKGROUND

On 30 September 2003, applicants filed international application PCT/US2003/030720. The international application claimed a priority date of 02 October 2002, and it designated the United States. The deadline for submission of the basic national fee was thirty months from the priority date, i.e., 02 April 2005.

Applicants did not submit the basic national fee prior to the expiration of the thirty-month deadline. Accordingly, the application became abandoned with respect to the United States at midnight on 02 April 2005.

On 12 April 2005, applicants filed a Transmittal Letter for entry into the national stage in the United States accompanied by, among other materials, payment of the basic national fee and a petition for revival of the application under 37 CFR 1.137(b).

In a decision mailed by this Office on 04 January 2006, applicants' petition for revival was granted.

On 17 February, applicants filed declarations executed by eleven of the fifteen inventors herein, as well as two separate petitions under 37 CFR 1.47(a). One of these petitions requested acceptance of the application without the signature of inventors Qing ZHAO and Feiyan REN, whom applicants assert are "unreachable." The other petition requested acceptance of the

application without the signature of inventor Tom WEHRMAN, whom applicants asserted was “an uncooperative inventor.”

On 07 April 2006, the United States Designated/Elected Office (DO/EO/US) mailed a Notification Of Missing Requirements (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497 was required.

On 07 July 2006 applicants filed a response to the Notification Of Missing Requirements that included a third petition under 37 CFR 1.47(a) requesting acceptance of the application without the signature of inventor Yunqing MA, whom applicants asserted was “an uncooperative inventor.”

On 27 July 2006, the DO/EO/US mailed a Notification Of Defective Response (Form PCT/DO/EO/906) indicating that the oath or declaration filed by applicants was not properly executed.

On 28 July 2006, applicants filed a declaration executed by previously non-signing inventor Yunqing MA.

On 03 August 2006, the DO/EO/US mailed a second Notification Of Defective Response (Form PCT/DO/EO/916) indicating that the oath or declaration filed by applicants was not properly executed.

DISCUSSION

1. Notifications Mailed By The DO/EO/US:

As set forth above, applicants filed the first two petitions under 37 CFR 1.47(a) on 17 February 2006, accompanied by declarations executed by eleven of the inventors. No further Notifications should have been mailed to applicants regarding the declaration requirement until a decision was issued on the petitions. Accordingly, the Notification Of Missing Requirements mailed 07 April 2006 and the Notifications Of Defective Response mailed 27 July 2006 and 03 August 2006, each of which required submission of a properly executed declaration in compliance with 37 CFR 1.497, are appropriately vacated.

2. Petition Under 37 CFR 1.47(a) Filed 07 July 2006 (MA):

The petition under 37 CFR 1.47(a) filed 07 July 2006 requested acceptance of the application without the signature of inventor Yunqing MA. However, on 28 July 2006, applicants filed an acceptable declaration executed by this inventor.

Based on the subsequent submission of a declaration executed by this inventor, the petition under 37 CFR 1.47(a) filed 07 July 2006 with respect to inventor Yunqing MA is appropriately dismissed as moot.

3. Petitions Under 37 CFR 1.47(a) Filed 17 Feb. 2006 (REN, ZHAO, and WEHRMAN):

A grantable petition under 37 CFR 1.47(a) must be accompanied by: (1) the fee under 37 CFR 1.17; (2) a statement of the last known address of the non-signing inventor; (3) an oath or declaration executed by the other inventors on behalf of themselves and the non-signing inventor; and (4) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort.

Applicants here have submitted the required petition fee. Item (1) is therefore satisfied.

The petitions filed 17 February 2006 include an express statement of the last known addresses for non-signing inventors Feiyan REN, Qing ZHAO, and Tom WEHRMAN. Item (2) is therefore satisfied.

Regarding item (3), section 409.03(a) of the Manual of Patent Examining Practice (MPEP) states that:

An oath or declaration signed by all the available joint inventors with the signature block of the nonsigning inventor(s) left blank may be treated as having been signed by all the joint inventors on behalf of the nonsigning inventor(s), unless otherwise indicated.

Here, as of the 28 July 2006 submission of the declaration executed by inventor Yunqing MA, applicants had submitted declarations executed by each of the twelve cooperating inventors, all of which included unsigned signature blocks for the three non-signing inventors. These declarations may be treated as having been executed by the signing inventors on their own behalf and on behalf of the non-signing inventors. Accordingly, item (3) is satisfied.

Regarding item (4), applicants assert that non-signing inventors Qing ZHAO and Feiyan REN are "unreachable." Section 409.03(d) of the MPEP states the following regarding such cases:

Where inability to find or reach a nonsigning inventor "after diligent effort" is the reason for filing under 37 CFR 1.47, a statement of facts should be submitted that fully describes the exact facts which are relied on to establish that a diligent effort was made. ...

The statement of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted. Copies of documentary evidence such as internet searches, certified mail return receipts, cover letters of instructions, telegrams, that support a finding that the nonsigning inventor could not be found or reached should be made part of the statement. The steps taken to locate the whereabouts of the nonsigning inventor should be

included statement of facts. It is important that the statement contain facts as opposed to conclusions.

Here, applicants have not provided an acceptable showing that inventors Qing ZHAO and Fieyan REN cannot be reached or located after diligent effort. Applicants have provided copies of materials purportedly directed, unsuccessfully, to the last known addresses of inventors Qing ZHAO and Fieyan REN. However, applicants have not provided a statement from a person with firsthand knowledge of this mailing to confirm the asserted facts (i.e., Elena Quertermous, the person who signed the letters). Moreover, applicants have not provided any evidence describing efforts made to locate these inventors after it was determined that their last known addresses were no longer current. Applicants must supplement the present submission with the required firsthand statement(s) confirming the previous actions taken to contact the inventors (i.e., the mailings discussed herein), as well as firsthand statement(s) detailing the additional efforts made to locate these non-signing inventors. Such efforts should include, but not be limited too, performing internet searches. As discussed in the MPEP section quoted above, applicants' submission should be accompanied by available documentary support (i.e., a copy of the results of internet searches conducted, etc.). Based on the above, item (4) of a grantable petition is not satisfied with respect to inventors Qing ZHAO and Fieyan REN.

With respect to the third non-signing inventor, Tom WEHRMAN, applicants assert that the inventor is "uncooperative" (interpreted herein as a claim that this inventor has refused to execute the application). Pursuant to MPEP section 409.03(d), before it can be concluded that an applicant refuses to sign the application papers, firsthand evidence must be provided confirming that a copy of the complete application (including specification drawings and claims) has been sent to the last known address of the inventor. The petition here states that a copy of the application and a request for signature were delivered to the inventor's last known address (copies of the materials and a Federal Express delivery receipt have been provided). However, applicants have not provided a firsthand statement confirming this mailing, as required. Moreover, the application papers were sent to Mr. WEHRMAN at a business address. Where the Office is being asked to accept the silence of the non-signing inventor as evidence of a refusal to sign, petitioner must provide some evidence that the non-signing applicant has received the application materials. In this situation, the application papers should be submitted to the inventor at his last known home address, to insure receipt.

The petition also refers to attempts to contact the inventor by email and telephone; however, applicants have not provided the required firsthand statement(s) from the person(s) who made such attempts, as required before such assertions may be considered.

Based on the above, the present record does not provide an acceptable showing that non-signing inventor Tom WEHRMAN has refused to execute the application. Item (4) of a grantable petition is therefore not satisfied with respect to this inventor.

CONCLUSION

The Notification Of Missing Requirements (Form PCT/DO/EO/905) mailed 07 April 2006 and the Notifications Of Defective Response (Form PCT/DO/EO/906) mailed 27 July 2006 and 03 August 2006 are hereby **VACATED**.

The petition under 37 CFR 1.47(a) for acceptance of the application without the signature of Yunqing MA, filed 07 July 2006, is **DISMISSED** as moot.

The petition under 37 CFR 1.47(a) for acceptance of the application without the signatures of Qing ZHAO, Fieyan REN, and Tom WEHRMAN, filed 17 February 2006, is **DISMISSED** without prejudice for failure to satisfy all the requirements of a grantable petition.

If reconsideration on the merits of the petition is desired, a proper response must be filed within **TWO (2) MONTHS** of the mail date of the present decision. Any request for reconsideration should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)" and must include the materials required to satisfy item (4) of a grantable petition with respect to these inventors, as discussed above. No additional petition fee is required.

Failure to file a proper response will result in abandonment of the application. Extensions of time are available under 37 CFR 1.136(a)

Please direct further correspondence with respect to this matter to Mail Stop PCT, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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